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EXAMINER

CHANKONG, DOHM

ART UNIT	PAPER NUMBER
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2452

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/774,877	Applicant(s) SIMPSON, TODD	
	Examiner DOHM CHANKONG	Art Unit 2452	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This action is in response to Applicant's request for continued examination. Claims 14-18, 24, 29, 37, 40, 41, 45-47, and 49-56 are amended. Claims 14-56 are presented for further examination.

2. This action is a non-final rejection.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/23/2009 has been entered.

Response to Arguments

4. It is first noted that Applicant has failed to address the §112 rejection of claims 14-56 that was set forth in the previous action. Because the amended claims still contain subject matter that was not supported by Applicant's specification, the rejection is maintained. Applicant's new limitations are also deficient for containing subject matter that was not described in Applicant's specification. To overcome these §112 rejections, Applicant should either amend the claims to contain subject that is supported by Applicant's specification or cite to specific sections in the specification that support the limitations.

5. Additionally, claims 14-36 are rejected under §101 for being directed towards non-statutory subject matter. Applicant had attempted to overcome this rejection through a previous amendment which introduced a "sender subsystem" and a "receiver subsystem" to the claims. The examiner had previously accepted this amendment as overcoming the rejection however upon careful consideration of Applicant's specification, the claimed subsystem is merely software and therefore not directed to statutory subject matter.

Applicant argues in the remarks filed on 4/30/2008 that "the systems as claimed in claims 14-36 are not software per se, but rather, a novel and inventive system *controlled by software systems executing on suitable hardware*." The problem with this argument is that the claims do not claim any type of hardware. Instead, the claims are directed to a system comprising subsystems. Based on the original claim language filed on 8/1/2006, a subsystem is merely an agent. Applicant simply amended "agent" which the specification defines as "any software system, or a combination of software and hardware systems" [0025]. Thus, while the agent may be interpreted as including hardware, the agent *may also be interpreted as being software only*. To avoid this interpretation, the claim *must include a hardware element*.

Based on the specification, Applicant describes that the subsystem may contain a storage unit [0030]. A storage unit is generally known in the art as being a hardware element and therefore this §101 rejection may be overcome if claims 14 and 24 were amended to include the storage unit as part of the subsystems. Until then however, the subsystems may still be interpreted as software only and therefore are rejected under §101 for being directed toward non-statutory subject matter.

6. After careful consideration of the claims and the cited references, Applicant's amendment to the independent claims fail to overcome the cited Gross reference. The amendment attempts to further define the negotiation process between a receiver and a sender. The sender proposes a category to a receiver which may be accepted or rejected by the receiver. If accepted, the category is used to classify the message. Gross teaches this feature.

Specifically, Gross teaches "[i]t will also be appreciated that *a sender can make suggestions to a receiver--by, for example, means of a message--to add processing criteria not yet known to the receiver, which the receiver can confirm to accept or reject*" [0263]. Gross' processing criteria are tags used to categorize the emails [0044, 0045]. In other words, the sender may suggest or "propose" a new alternative category to the receiver which the receiver may deem acceptable. Thus, the sender and receiver reach a "common ground" between the sender's suggestion and the receiver's acceptance of that suggestion. This teaching is a type of interactive negotiation because the sender dynamically suggests new categories which the receiver may accept or rejection and reads on Applicant's new limitation.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 14-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The current position of the Patent Office in regard to statutory inventions under 35 U.S.C §101 for software claims is that software *per se* does not fall into any

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of the statutory categories. That is, software *per se* is neither a process, a machine, a manufacture, or a composition of matter.

Independent claim 14 is directed to "an e-mail system" that comprises a sender subsystem and a receiver subsystem. Based on the claim language and Applicant's specification, a subsystem may still be interpreted as software. Thus, claim 14 is directed merely to software *per se* and do not contain subject matter that falls within a statutory category. Thus, claim 14 is rejected under 35 U.S.C §101 as failing to fall within a statutory category. As to claims 15-23, they do not cure any of above cited deficiencies of claim 14 and are therefore rejected for at least the same reasons set forth for claim 14.

Independent claim 24 is directed to a system that comprises a negotiation module that includes both the sender and receiver subsystem. For the same reasons discussed with respect to claim 14, claim 24 is also rejected under 35 U.S.C. §101 as failing to fall within a statutory category. As to claims 25-36, they do not cure any of the above cited deficiencies of claim 24 and therefore are rejected for at least the same reasons set forth for claim 24.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 14, 24, 37, 47, and 52 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the

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relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Taking claim 14 as an example of the other independent claims, these claims have been amended to recite, *inter alia*:

“and adopting the category as a negotiated category if the category is acceptable or, if the category is not acceptable, negotiating with the receiver subsystem by proposing an alternative category to the receiver subsystem and adopting the alternative category as the negotiated category if the alternative category is acceptable to the receiver subsystem, to associate the negotiated category with the message, and to transmit the categorized message to the receiver subsystem.”

This limitation is new matter. There is no description of this feature in Applicant’s specification. Specifically, while there is some discussion of a sender proposing a first (new) category to a user, there is no discussion in the specification of a sender proposing an *alternative* category when a first suggested category is deemed “not acceptable” nor is there any discussion of the receiver adopting the *alternative* category. There is no discussion in Applicant’s specification of any “interactive” negotiation between the sender and receiver subsystem. Moreover, there is no disclosure describing that the negotiation process includes the receiver sending an indication that a sender-proposed category is acceptable. If Applicant disagrees with this rejection, Applicant should point out the description in the specification that explicitly supports the claimed feature.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 14-17, 20-43, and 47-56 are rejected under 35 U.S.C. §103(a) as being unpatentable over Schiavone et al, U.S Patent Publication No. 2002|0120600 ["Schiavone"], in view of Gross et al, U.S Patent Publication No. 20040111478 ["Gross"].

10. All citations are to Schiavone unless otherwise noted.

11. As to claim 14, Schiavone as modified by Gross discloses an e-mail system for exchanging messages among users of the system, the system comprising:

a sender subsystem for transmitting a message from a sender to a receiver, the sender subsystem having access to a list of categories [0062 : Schiavone's mailing software 170 reads on Applicant's claimed sender subsystem | 0026 : senders "share knowledge of a common set of message type specifiers" where Schiavone's specifier reads on Applicant's claimed category]; and

a receiver subsystem for receiving the message, the receiver subsystem being in data communication with the sender subsystem [0064 : the "recipient's communication device 150" reads on Applicant's claimed receiver subsystem | 0026];

wherein the receiver subsystem is configured to permit the sender subsystem to propose new categories for adding to a listing of receiver categories [*Gross*, 0263: sender making suggestions to the receiver], and

wherein the sender subsystem is configured to identify a category for the message based on the listing of categories [0035 | 0062 : receiver sharing knowledge with the mailing software

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and the mailing software selecting a mail-type specifier based on a list of shared specifiers], to initiate a categorization negotiation process with the receiver subsystem [0051: negotiating the delivery of the email messages], that includes at least the steps of communicating the category to the receiver subsystem [*Gross*, 0263], receiving an indication from the receiver subsystem whether the category is recognized by the receiver subsystem and adopting the category as a negotiated category if the category is acceptable or, if the category is not acceptable, negotiating with the receiver subsystem by proposing an alternative category to the receiver subsystem and adopting the alternative category as the negotiated category if the alternative category is acceptable to the receiver subsystem [*Gross*, 0263: receiver may accept or reject the proposed category, 0268: sending an indication to the sender to recategorize a message according to newly accepted categories], to associate the negotiated category with the message [*Gross*, 0046, 0263, 0268], and to transmit the categorized message to the receiver subsystem [0062-0064].

As indicated above, Schiavone does not expressly disclose that receiver subsystem is configured to permit the sender subsystem to propose new categories for adding to a listing of receiver categories or the feature of proposing an alternative category to the receiver subsystem if the category is not acceptable. However, these features were well known in the art at the time of Applicant's invention. *Gross* is directed towards a system in which users identify how messages are to be processed using categorization techniques [0013]. *Gross* further discloses permitting the sender subsystem to propose new categories for adding to a listing of receiver categories [0263], proposing an alternative category if the category is not acceptable [0046, 0268], and a sender subsystem associating a category with a message upon receiving an

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indication that a receiver subsystem recognizes the category [0046: the receiver-approved tags are transmitted to the sender as the sender composes the message | 0263 | 0268].

It would have been obvious to one of ordinary skill in the art to have modified Schiavone's system for negotiating email transactions to have included Gross' teachings. Specifically, one would have been motivated to include the feature of enabling a receiver to either accept or reject sender-proposed categories into Schiavone's negotiations functionality. Such a feature improves Schiavone's system because in allowing a receiver to restrict the distribution of the categories, messages may be appropriately categorized and processed according to the receiver's control [see Gross, 0044].

12. As to claim 15, Schiavone discloses the recognized category is identical to a receiver category [0062 : "list of shared specifiers"].

13. As to claim 16, Schiavone discloses the recognized category is mapped from a receiver category [0062 : negotiated specifier is selected from the list].

14. As to claim 17, Schiavone discloses the recognized category is a new category added to a listing of receiver categories [0025 : Schiavone discloses scanning the text of the message and creating a new specifier based on the text of the message. Thus, the specifier is newly added. Also see Gross, 0261].

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15. As to claim 20, Schiavone discloses an intermediary subsystem, wherein the listing of categories is provided to the sender subsystem through the intermediary subsystem [0026].

16. As to claim 21, Schiavone does not expressly disclose that the listing of categories is a union of a first listing provided by the intermediary subsystem and a second listing provided by the sender subsystem. However, Schiavone does disclose that the listing of categories is a result of shared “knowledge of a common set of message type specifiers” [0026]. The term “common set” is well known to refer to a set of items in common between two different sets. Thus, it would have been obvious for one of ordinary skill in the art to have reasonably inferred from Schiavone’s use of the term “common set” that the listing of categories was a result of a union of message type specifiers provided by the sender and the third party.

17. As to claim 22, Schiavone does not expressly disclose a sender intermediary subsystem for communicating with said intermediary subsystem to negotiate said category. However, the concept of distributing different functionalities between different network elements, such as from a sender to a sender’s intermediary, is well known and obvious. Schiavone does disclose that his system can be implemented by spreading out different functionalities to multiple third party intermediaries [0066]. Thus, it would have been obvious to one of ordinary skill in the art to have implemented Schiavone with a sender intermediary subsystem to perform the sender's responsibilities.

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18. As to claim 23, Schiavone discloses a user interface for presenting the listing of categories to the sender subsystem to select the category therefrom [0025 : specify a mail type specifier by selection from a menu].

19. As to claim 24, Schiavone discloses a system for classifying messages transmitted by a message exchange system, the message exchange system including a sending subsystem for transmitting a message from a sender to a receiver and a receiving subsystem for receiving the message, the system comprising:

a negotiation module, the negotiation module maintaining a listing of categories [0064 : Schiavone's trust authority 200 reads on a negotiation module];

said negotiation module including a sender subsystem for initiating negotiation of a category and a receiver subsystem for providing the sender subsystem with an indication whether the category is acceptable to the receiver system [*Gross*, 0263, 0268],

wherein the receiver subsystem is configured to permit the sender subsystem to propose new categories for adding to a listing of receiver categories [*Gross*, 0263: sender making suggestions to the receiver], and

wherein the sender subsystem is configured to identify a category for the message based on the listing of categories [0035 | 0062 : receiver sharing knowledge with the mailing software and the mailing software selecting a mail-type specifier based on a list of shared specifiers], to initiate a categorization negotiation process with the receiver subsystem [0051: negotiating the delivery of the email messages], that includes at least the steps of communicating the category to the receiver subsystem [*Gross*, 0263], receiving an indication from the receiver subsystem

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whether the category is recognized by the receiver subsystem and adopting the category as a negotiated category if the category is acceptable or, if the category is not acceptable, negotiating with the receiver subsystem by proposing an alternative category to the receiver subsystem and adopting the alternative category as the negotiated category if the alternative category is acceptable to the receiver subsystem [*Gross*, 0263: receiver may accept or reject the proposed category, 0268: sending an indication to the sender to recategorize a message according to newly accepted categories], to associate the negotiated category with the message [*Gross*, 0046, 0263, 0268. See the rejection of claim 14 for reasons to modify Schiavone to include Gross' interactive negotiation process.

Schiavone also discloses a sender subsystem for initiating negotiation of a category and a receiver subsystem for providing the sender subsystem with the listing of categories [0026, 0064, 0066] however Schiavone does not expressly disclose that the sender and receiver subsystems are included in the negotiation module. However, the concept of distributing different functionalities between different network elements, such as from a sender to a sender's intermediary, is well known and obvious. Schiavone does disclose that his system can be implemented by spreading out different functionalities to multiple third party intermediaries [0066]. Thus, it would have been obvious to one of ordinary skill in the art to have implemented Schiavone with a sender intermediary subsystem to perform the sender's responsibilities.

20. As to claim 25, Schiavone discloses said sender subsystem having access to a listing of sender categories and is operative to deduce the category from the listing of categories

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maintained by the negotiation module and the listing of sender categories [0026, 0062 : “list of shared specifiers” : also see the rejection of claim 21].

21. As to claim 26, Schiavone discloses the category is a common category belonging to the listing of sender categories and the listing of categories maintained by the negotiation module [0026 : also see the rejection of claim 21].

22. As to claims 27 and 28, Schiavone does not disclose the category belonging to one of the two listings and is mapped or is a new category to a second category belonging to the other of the two listings. However, such a feature was well known in the art at the time of Applicant's invention. For example, Gross discloses the feature. Specifically, Gross discloses selecting a category from a receiver listing and mapping it (or adding a new category) to a sender listing and allowing the sender to use the category specified by the receiver listing [0010, 0217]. It would have been obvious to one of ordinary skill in the art to have modified Schiavone's email system to include Gross' teachings of mapping new categories to a sender. Enabling the receiver to specify the categories used by the sender gives a receiver more control over the categories that may be used by the sender.

23. As to claim 29, Schiavone discloses the message exchange system further includes a plurality of receiving subsystems for receiving the message for a plurality of receivers [0065], said negotiation module further including a plurality of receiver subsystems, each of said plurality of receiver subsystems being operative to provide said sender subsystems with an

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indication that the category is recognized by each receiver subsystem [0026, 0066 : the recipient compliance engine as part of the negotiation module | see rejection of claim 14].

24. As to claim 30, Schiavone discloses establishing a common category for a subset of said plurality of receivers and to associate said common category with the message for said subset of receivers [0055].

25. As to claim 31, Schiavone discloses the use of one or more intermediary subsystems, said one or more intermediary subsystems having access to at least a separate listing of additional categories, and wherein the category is identified from a union of said separate listing of additional categories and the listing of categories [0026 : see rejection of claim 21 with respect to the concept of a “common set.” Adding “additional categories” would have been obvious to one of ordinary skill in the art because a “common set” can refer to the union of multiple sets of items].

26. As to claims 32 and 34, Schiavone discloses one of said one or more intermediary subsystems is selected by said receiver subsystem or sender subsystem [0030 – selecting a trusted authority]. Schiavone does not expressly disclose that the subsystems select the authority. However, such a feature is implied by Schiavone’s teaching that the sender and receiver have a shared common set of specifiers. This teaching implies that the sender and receiver have selected an intermediary to which to send their set of specifiers.

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27. As to claim 33, Schiavone does not expressly disclose a search module for searching for an selecting said one or more intermediary subsystems. However, such a feature is implied by Schiavone's teachings that there can be more than one intermediary subsystem [0066 : trusted authority and/or another third party]. Since there are multiple intermediaries in Schiavone's system, it would have been obvious to one of ordinary skill in the art to have reasonably inferred the use of a method to search and select from one of the multiple intermediaries.

28. As to claim 35, Schiavone discloses presenting to a sender the listing of categories for the sender to select the category therefrom [0025 – menu].

29. As to claim 36, Schiavone discloses said negotiation module is configurable through the user interface to either negotiate the category free of interactive input from the sender or to receive an indication of the category from the sender through the user interface [0025 – sender selects a specifier].

30. As to claims 37 and 52, as they do not teach or further define over the limitations of claim 14, claims 37 and 52 are rejected for at least the same reasons set forth for claim 14.

31. As to claim 38, as it does not teach or further define over the limitations of claim 15, claim 38 is rejected for at least the same reasons set forth for claim 15.

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32. As to claims 39 and 54, as they do not teach or further define over the limitations of claim 23, claims 39 and 54 are rejected for at least the same reasons set forth for claim 23.

33. As to claim 40, as it does not teach or further define over the limitations of claim 16, claim 40 is rejected for at least the same reasons set forth for claim 16.

34. As to claims 41 and 53, as they do not teach or further define over the limitations of claims 16 and 17, claims 41 and 53 are rejected for at least the same reasons set forth for claims 16 and 17.

35. As to claim 42, as it does not teach or further define over the limitations of claims 20 and 21, claim 42 is rejected for at least the same reasons set forth for claims 20 and 21.

36. As to claim 43, Schiavone discloses obtaining the listing of categories includes:
obtaining a first listing of a first plurality of categories from a first intermediary,
retrieving a second list of a second plurality of categories from a storage location maintained by said receiver subsystem, producing the listing of categories from a union of the first listing and the second listing [0026, 0064]. Schiavone discloses that the listing of categories is a result of shared “knowledge of a common set of message type specifiers”. The term “common set” is well known to refer to a set of items in common between two different sets. Thus, it would have been obvious for one of ordinary skill in the art to have reasonably inferred from Schiavone’s use of the term “common set” that the listing of categories was a result of a union of message type

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specifiers provided by the sender and the third party. Additionally, Schiavone discloses the receiver storing public preference data at the recipient's data store while the sender retrieves categories from a trusted intermediary.

37. As to claim 47, Schiavone discloses a method of transmitting a message to a receiver for a sender in a message exchange system, the sender having a sender subsystem for sending the message and the receiver having a receiver subsystem for receiving the message, the sender subsystem having access to a listing of categories recognized by the receiver subsystem [see rejection of claim 14], the method comprising:

obtaining a destination address from the sender for identifying the receiver [0023 – use of an the receiver's email address];

receiving information from the sender to be included in the message [0025 – specifier based on content];

the sender subsystem negotiating a category with the receiver subsystem, the category being identified by the sender subsystem based on the information and the listing of categories [0026];

associating negotiated the category with the message [0025]; and

transmitting the categorized message to the receiver subsystem, the message being associated with the category [0024, 0025],

wherein the step of negotiating includes at least the substeps of communicating the category to the receiver subsystem [*Gross*, 0263], receiving an response from the receiver subsystem whether the category is recognized by the receiver subsystem and either adopting the

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category as a negotiated category if the category is acceptable or, if the category is not acceptable, negotiating with the receiver subsystem by proposing an alternative category to the receiver subsystem and adopting the alternative category as the negotiated category if the alternative category is acceptable to the receiver subsystem [*Gross*, 0263: receiver may accept or reject the proposed category, 0268: sending an indication to the sender to recategorize a message according to newly accepted categories].

Schiavone does not expressly disclose the negotiating substeps. However, these substeps were well known in the art at the time of Applicant's invention. See the rejection of claim 14 for reasons to modify Schiavone to include Gross' interactive negotiation process.

38. As to claims 48-51, as they do not teach or further define over the limitations of claims 15-17 and 20, claims 48-51 are rejected for at least the same reasons set forth for claims 15-17 and 20.

39. As to claims 55 and 56, Schiavone discloses inserting an indication of the category in a section or header of the message [0024].

40. Claims 18, 19, and 44-46 are rejected under 35 U.S.C. §103(a) as being unpatentable over Schiavone and Gross, in view of Schiavone et al, U.S Patent Publication No. 20020120748 [“Koenig”].

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41. It should be noted that Koenig describes additional aspects of Schiavone's invention.

Schiavone makes explicit reference to the Koenig application [0068 : "Selective Delivery and Forwarding of Electronic Mail"]. Therefore, it would have been clear to one of ordinary skill in the art to have incorporated Koenig and Schiavone together to fully realize Schiavone's invention.

42. As to claims 18 and 19, Schiavone does not expressly disclose storing or indexing the message according to the negotiated category. However, describing an additional aspect of Schiavone's email system, Koenig discloses using the message specifiers (or identifiers) to store and index a copy of the categorized email messages in a categorized inbox [0039 : specifiers including "personal", "business"].

43. As to claim 44, Schiavone does not expressly disclose storing the categorized message together with an indication of the category associated therewith. However, Koenig describes this aspect of Schiavone's invention [0039].

44. As to claims 45 and 46, as they do not teach or further define over the limitations of claims 18 and 19, claims 45 and 46 are rejected for at least the same reasons set forth for claims 18 and 19.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOHM CHANKONG whose telephone number is (571)272-3942. The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571.272.3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dohm Chankong/
Examiner, Art Unit 2452